

**REMARKS**

This Application has been carefully reviewed in light of the Final Office Action mailed February 12, 2007. To clarify various aspects of inventive subject matter, Applicant amends Claims 1, 14, 18, 36, 43, 76, 80, and 84. Applicant also introduces new Claims 87-92 and cancels Claims 9, 25, 54, 55, 63, and 64 without prejudice or disclaimer. To advance prosecution of this application, Applicant has responded to each notation by the Examiner. Applicant submits that all of the pending claims are in a condition of allowance. Applicant respectfully requests reconsideration, further examination, and favorable action in this case.

**Claim Rejections – 35 U.S.C. §103**

The Examiner rejects Claims 36, 41, 43, 47, 68, 73-74, and 83-86 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '167* in view of U.S. Patent No. 6,333,803 by Kurotori et al. ("*Kurotori*"). The Examiner also rejects Claim 36 U.S.C. § 103(a) as being unpatentable over *Arthurs '187* in view of *Kurotori*. The Examiner also rejects Claims 69-70 U.S.C. § 103(a) as being unpatentable over *Arthurs '167* in view of *Kurotori* and in further view of *Okayama*. The Examiner also rejects Claims 1, 7-8, 11, 14, 49, 52, 55, and 75-78 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '167* in view of *Cheung* and in further view of *Kurotori*. The Examiner also rejects Claim 9 U.S.C. § 103(a) as being unpatentable over *Arthurs '167* in view of *Kurotori* and *Cheung* and in further view of *Dantu*. The Examiner also rejects Claims 50-51 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '167* in view of *Kurotori* and *Cheung* and in further view of *Okayama*. The Examiner also rejects Claim 54 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '167* in view of *Kurotori* and in further view of *Labriola*. The Examiner also rejects Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '681* in view of *Cheung* and in further view of *Kurotori*. The Examiner also rejects Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '681* in view of *Kurotori* and *Cheung* and in further view of *Arthurs '167*. The Examiner also rejects Claims 18, 24, 27, 35, 56, 58, 61, 64-66, and 79-82 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '681* in view of *Arthurs '167* and in further view of *Kurotori*. The Examiner also rejects Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '681* in view of *Arthurs '167* and *Kurotori* and in further view of *Dantu*. The Examiner also rejects Claims 59-60 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '681* in view of *Arthurs '167* and *Kurotori* and in further

view of *Okayama*. The Examiner also rejects Claim 63 under 35 U.S.C. § 103(a) as being unpatentable over *Arthurs '681* in view of *Arthurs '167* and *Kurotori* and in further view of *Labriola*. Applicant respectfully traverses these claim rejections for the reasons discussed below.

Applicant provides a reminder that to defeat a patent under 35 U.S.C. § 103, “the prior art reference must teach, disclose, or suggest all the claim limitations.” *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). Applicant respectfully submit that *Arthurs '167*, *Arthurs '681*, *Cheung*, *Kurotori* and/or knowledge supposedly generally available to those of ordinary skill in the art at the time of the invention, taken alone or in combination, fail to teach or suggest, either expressly or inherently, a number of elements of independent Claim 36.

**A. The Proposed *Arthurs '167-Cheung-Kurotori*, and *Arthurs '681-Cheung-Kurotori* Combinations Fail to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 1**

Applicant submits that amended Claim 1 is patentable over *Arthurs '167* in view of *Cheung* and further in view of *Kurotori*, and over *Arthurs '681* in view of *Cheung* and further in view of *Kurotori*. Among other features, amended Claim 1 recites, in part, that “the optical transmitter comprises a super-continuum source, the super-continuum source coupled to one or more modulators operable to modulate information onto an output from the super-continuum source.” Amended Claim 1 also recites, in part, that “the super-continuum source comprises a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

*Arthurs '167* fails to teach or suggest a number of elements of amended Claim 1. For example, nowhere does *Arthurs '167* contemplate that the optical transmitter comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber

comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. Consequently, *Arthurs '167* fails to teach or suggest that the optical transmitter comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

*Arthurs '681* also fails to teach or suggest a number of elements of amended Claim 1. For example, nowhere does *Arthurs '681* contemplate that the optical transmitter comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. Consequently, *Arthurs '681* fails to teach or suggest that the optical transmitter comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

The *Cheung* reference fails to atone for the deficiencies of *Arthurs '167* and *Arthurs '681*. For example, *Cheung* fails to disclose, teach, or suggest that an optical transmitter comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. Consequently, *Cheung* fails to teach or suggest that the optical transmitter comprises a

super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

Finally, the *Kurotori* also fails to atone of the deficiencies of the *Arthurs* '167, *Arthurs* '681, and *Cheung* references. For example, *Kurotori* fails to disclose, teach, or suggest that an optical transmitter comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. To the extent that *Kurotori* discusses a length of optical fiber coupled to an end of an optical amplifier, this discussion is limited to an optical fiber having one dispersion. (See Col. 3, Lines 19-23; see also Col. 3, Lines 38-41). Moreover, nowhere does *Kurotori* teach or suggest a super-continuum source that includes a pulsed source that generates a series of optical pulses. Consequently, *Kurotori* fails to teach or suggest that the optical transmitter comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

For at least these reasons, Applicant submits that *Arthurs* '167, *Arthurs* '681, *Cheung*, and/or *Kurotori* taken alone or in combination, fail to teach or suggest amended Claim 1. Applicant respectfully requests withdrawal of the rejection and full allowance of independent Claim 1 and all claims depending therefrom.

**B. The Proposed *Arthurs '681-Arthurs '167-Kurotori* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 18**

Applicant submits that amended Claim 18 is patentable over *Arthurs '681* in view of *Arthurs '167* and further in view of *Kurotori*. Among other features, amended Claim 18 recites, in part, that “the optical transmitter comprises a super-continuum source, the super-continuum source coupled to one or more modulators operable to modulate information onto an output from the super-continuum source.” Amended Claim 18 also recites, in part, that “the super-continuum source comprises a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

*Arthurs '681* fails to teach or suggest a number of elements of amended Claim 18. For example, nowhere does *Arthurs '681* contemplate that the optical transmitter comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. Consequently, *Arthurs '681* fails to teach or suggest that the optical transmitter comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

*Arthurs '167* fails to atone for the deficiencies of *Arthurs '681*. For example, nowhere does *Arthurs '167* contemplate that the optical transmitter comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical

pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. Consequently, *Arthurs '167* fails to teach or suggest that the optical transmitter comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

Moreover, the *Kurotori* reference also fails to atone of the deficiencies of the *Arthurs '681* and *Arthurs '167* references. For example, *Kurotori* fails to disclose, teach, or suggest that an optical transmitter comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. To the extent that *Kurotori* discusses a length of optical fiber coupled to an end of an optical amplifier, this discussion is limited to an optical fiber having one dispersion. (See Col. 3, Lines 19-23; see also Col. 3, Lines 38-41). Moreover, nowhere does *Kurotori* teach or suggest a super-continuum source that includes a pulsed source that generates a series of optical pulses. Consequently, *Kurotori* fails to teach or suggest that the optical transmitter comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

For at least these reasons, Applicant submits that *Arthurs '167*, *Arthurs '681*, and *Kurotori* taken alone or in combination, fail to teach or suggest amended Claim 18.

Applicant respectfully requests withdrawal of the rejection and full allowance of independent Claim 18 and all claims depending therefrom.

**C. The Proposed *Arthurs '167-Kurotori* and *Arthurs '167-Kurotori* Combinations Fail to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 36**

Applicant submits that amended Claim 36 is patentable over *Arthurs '167* in view of *Kurotori* and *Arthurs '681* in view of *Kurotori*. Among other features, amended Claim 36 recites, in part, that “at least one of the one or more transmitters comprises a super-continuum source, the super-continuum source coupled to one or more modulators operable to modulate information onto an output from the super-continuum source.” Amended Claim 36 also recites, in part, that “the super-continuum source comprises a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

*Arthurs '167* fails to teach or suggest a number of elements of amended Claim 36. For example, nowhere does *Arthurs '167* contemplate that at least one of the one or more optical transmitters comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. Consequently, *Arthurs '167* fails to teach or suggest that at least one of the one or more optical transmitters comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

*Arthurs '681* fails to teach or suggest a number of elements of amended Claim 36. For example, nowhere does *Arthurs '681* contemplate that at least one of the one or more optical transmitters comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. Consequently, *Arthurs '681* fails to teach or suggest that at least one of the one or more optical transmitters comprises a super-continuum source that comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

The *Kurotori* reference also fails to atone of the deficiencies of the *Arthurs '167* and *Arthurs '681* references. For example, *Kurotori* fails to disclose, teach, or suggest that at least one of the one or more optical transmitters comprises a super-continuum source that comprises a pulsed source operable to generate a series of optical pulses and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber. To the extent that *Kurotori* discusses a length of optical fiber coupled to an end of an optical amplifier, this discussion is limited to an optical fiber having one dispersion. (See Col. 3, Lines 19-23; see also Col. 3, Lines 38-41). Moreover, nowhere does *Kurotori* teach or suggest a super-continuum source that includes a pulsed source that generates a series of optical pulses. Consequently, *Kurotori* fails to teach or suggest that at least one of the one or more optical transmitters comprises “a pulsed source operable to generate a series of optical pulses; and an optical amplifier comprising a first end that is coupled to the pulsed source and a second end coupled to a length of optical fiber, the length of optical fiber comprising at least a first stage fiber and a second stage fiber, wherein the first stage fiber comprises a first dispersion that is different than a second dispersion of the second stage fiber.”

For at least these reasons, Applicant submits that *Arthurs '167*, *Arthurs '681*, and *Kurotori* taken alone or in combination, fail to teach or suggest amended Claim 36. Applicant respectfully requests withdrawal of the rejection and full allowance of independent Claim 36 and all claims depending therefrom.

**D. The Proposed *Arthurs '167-Cheung-Kurotori*, *Arthurs '681-Cheung-Kurotori*, *Arthurs '681-Arthurs '167-Kurotori*, *Arthurs '167-Kurotori*, and *Arthurs '187-Kurotori* Combinations are Improper**

The rejection of Applicant's claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Arthurs '167*, *Arthurs '681*, *Cheung*, *Kurotori*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify the *Arthurs '167*, *Arthurs '681*, *Cheung*, or *Kurotori* references in the manner the Examiner proposes. The rejected claims are allowable for at least this additional reason.

**1. The Obviousness Standard**

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Arthurs '167*, *Arthurs '681*, *Cheung*, and/or *Kurotori* combinations do not, taken as a whole, suggest the claimed invention. Respectfully, it appears to Applicant that the Examiner has *merely pieced together disjointed portions of references, with the benefit of hindsight using Applicant's claims as a blueprint, in an attempt to reconstruct Applicant's claims.*

The governing Federal Circuit case law makes this strict legal standard clear.<sup>1</sup> According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* ***Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, ***“The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.”*** M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the

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<sup>1</sup> Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*'” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

## 2. Argument

According to the Examiner, it would have been obvious to a person of skill in the art at the time the invention was made to combine the teachings of *Arthurs '167* or *Arthurs '681*, with one or more of *Arthurs '167*, *Cheung*, and/or *Kurotori* references. The Examiner provides essentially no support in the *Arthurs '167* reference, *Arthurs '681* reference, *Cheng* reference, and/or the *Kurotori* reference for these assertions. Applicant respectfully submits that the Examiner's assertion that it would have been obvious to modify the teachings of *Arthurs '167* or *Arthurs '681* with one or more of *Arthurs '167*, *Cheung*, and/or *Kurotori* references to purportedly arrive at Applicant's invention is entirely insufficient to support a

*prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law. Consequently, the Examiner has not demonstrated the requisite teaching, suggestion, or motivation in either of the reference or in the knowledge that is supposedly generally available to one of ordinary skill in the art at the time of Applicant's invention to combine or modify these references in the manner the Examiner proposes.

It appears that the Examiner is merely proposing alleged advantages of modifying *Arthurs '167* or *Arthurs '681* with one or more of *Arthurs '167*, *Cheng*, or *Kurotori* (advantages which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited portions of *Arthurs '167*, *Arthurs '681*, *Cheng* and *Kurotori* the Examiner has not pointed to any portions of the cited references or to knowledge supposedly generally available to those of ordinary skill in the art at the time of the invention that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to modify the system disclosed in *Arthurs '167* or *Arthurs '681* as suggested by the Examiner. In other words, the alleged advantage of the system described by the Examiner does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Arthurs '167* or *Arthurs '681* as suggested by the Examiner; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of the claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

It certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the system disclosed in *Arthurs '167* or *Arthurs '681* with one or more of *Arthurs '167*, *Cheng*, or *Kurotori* in the manner proposed by the Examiner. Applicant respectfully submits that the Examiner's

attempt to modify or combine *Arthurs '167* or *Arthurs '681* with one or more of *Arthurs '167*, *Cheng*, or *Kurotori* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to modify *Arthurs '167* or *Arthurs '681* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

#### **D. Conclusion**

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 18, and 36, and claims depending therefrom.

#### **No Waiver**

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the *Arthurs '167*, *Arthurs '681*, *Cheung*, and *Kurotori* references. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the anticipation and obviousness rejections.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for allowance. Because this Amendment places all claims in condition for allowance or at least in a better condition for appeal, Applicant respectfully requests that this Amendment be entered..

Applicant believes no fee is due. However, the Commissioner is hereby authorized to charge any fee or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If the Examiner feels that a conference would advance prosecution of this Application in any manner, Brian J. Gaffney stands willing to conduct such a telephone interview at the convenience of the Examiner. Mr. Gaffney may be reached at (214) 953-6682.

Respectfully submitted,

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